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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERND BRUCHMANN, JOELLE BEDAT,
JURGEN KACZUN, PETER POGANIUCH,
EVA WAGNER, and JEAN-FRANCOIS STUMBE

Appeal 2009-013531
Application 10/510,438
Technology Center 1700

Before MICHAEL P. COLAIANNI, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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Appellants appeal under 35 U.S.C. § 134 the final rejection of claims 1 and 3-12. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

The subject matter on appeal is directed to a multilayer material.

The Examiner maintains the following rejections:

- 1) Claims 1 and 3-12² under 35 U.S.C. § 103(a) over Kaczun (WO 97/38849, published Oct. 23, 1997) and Anderson (6,316,538 B1, issued Nov. 13, 2001); and
- 2) Claim 5 under 35 U.S.C. § 103(a) over Kaczun and Anderson, and further in view of Peiffer (US 6,517,932 B1, issued Feb. 11, 2003).

REJECTION (1)

ISSUE

Did the Examiner err in determining that the combined teachings of Kaczun and Anderson would have rendered obvious the multilayer material having the hyperbranched polyester feature required by claim 1 within the meaning of § 103? We decide this issue in the affirmative.

² We note that the Examiner's rejection of claim 2 is harmless error since it is apparent from the amendment dated on October 4, 2007, that this claim has been canceled.

PRINCIPLE OF LAW

"[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

FACTUAL FINDINGS

1. The Specification discloses that the preferred synthesis of hyperbranched polyesters may take place via reacting "one or more dicarboxylic acids or one or more derivatives thereof with one or more alcohols having a functionality of at least three." (Spec. 8, ll. 31-41). The Specification discloses that "alcohols with a functionality of at least three . . . [may include] trimethylolpropane." (Spec. 9, ll. 41-45).
2. The Examiner states that

Anderson teaches aqueous dispersions used as film printing inks (abstract, 9: 1-41) employing a polyester using polycarboxylic acid (-COOH group) and their derivatives at 6:42-53 and 7:1-15 (acids including dicarboxylate, dicarboxylic and adipic acids) and additionally using a myraid of alcohols (-OH group) having more than two functional groups, such as trimethylol propane found at 6:58, which has three functional groups, which would produce hyperbranching as is consistent in meaning with Appellant's specification (page 8-page 10).

(Ans. 9).

ANALYSIS AND CONCLUSION

Appellants argue that "the general disclosure of the polymers used according to Anderson et al [sic] is rather unspecific." (Br. 10) (emphasis omitted). Specifically, Appellants argue that

the Examiner has failed to show that either Kaczun et al or Anderson et al . . . teach or suggest the specific hyperbranched polyester containing functional groups selected from OH, COON and COOR, having an acid number of from 1-200 mg KOH/g [sic] and having an OH number of from 50-500 mg KOH/g as is defined in the present applicants' claims on appeal.

(Br. 9) (emphasis omitted). We agree.

While the Examiner states (FF 2) that Anderson, like Appellants, teaches reacting, for example, a dicarboxylic acid with a trimethylolpropane, which would produce the hyperbranched polyester required by claim 1, the Examiner fails to direct us to any credible evidence or provide any persuasive explanation to show that Anderson teaches or would have suggested reacting a dicarboxylic acid *with* a trimethylol propane.

In this regard, the portion of Anderson relied upon by the Examiner to disclose a polycarboxylic acid and its derivatives such as a dicarboxylic acid (i.e., col. 6, ll. 42-53 and col. 7, ll. 1-15) is directed to forming a polyester or polyamide. Indeed, Anderson teaches that "[t]he preparation of polyesters or polyamides generally requires the use of polycarboxylic acids." (Anderson, col. 6, ll. 42-43).

In contrast, the portion of Anderson relied upon by the Examiner to disclose the trimethylol propane alcohol (i.e., col. 6, l. 58), is directed to forming a polyester glycol. Anderson teaches that "the preparation of polyester glycols will employ . . . trimethylol propane." (Anderson, col. 6, ll. 53-58).

Thus, the Examiner fails to direct us to any credible evidence or provide any persuasive explanation to show that Anderson teaches reacting a dicarboxylic acid *with* a trimethylol propane (e.g., reacting Anderson's dicarboxylic acid, which is used to form a polyester or polyamide, with

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Anderson's trimethylol propane, which is used to form a polyester glycol), to arrive at the hyperbranched polyester required by claim 1.

Moreover, the Examiner does not provide any reason or explanation, absent hindsight, why one of ordinary skill in the art would have selected trimethylol propane as a separate ingredient used to form polyester glycols according to Anderson to react with Anderson's dicarboxylic acid in order to form the hyperbranched polyester required by claim 1.

Thus, it follows that the Examiner erred in determining that the combined teachings of Kaczun and Anderson would have rendered obvious the multilayer material having the hyperbranched polyester feature required by claim 1 within the meaning of § 103.

Accordingly, for the reasons stated by Appellants in the Brief and above, we reverse the Examiner's rejection (1).

REJECTION (2)

The Examiner relies on the same factual findings and determinations discussed above to meet the disputed claim feature of independent claim 1 and does not provide any additional findings or determinations as to how Peiffer would satisfy this disputed claim feature. Therefore, for the reasons stated above, we reverse the Examiner's rejection (2).

DECISION

Accordingly, we reverse rejections (1) and (2).

Accordingly, the Examiner's decision is reversed.

REVERSED

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